

REMARKS

Claims 1-3, 5-20 and 33-45 are pending in the present application. By this Amendment, previously presented claims 1, 35, and 40 have been amended. Applicants respectfully request reconsideration of the present claims in view of the foregoing amendments and the following remarks.

I. Formal Matters:

Rejection Under 35 U.S.C. § 112, 2nd Paragraph

Previously presented claims 16-18 were rejected as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This rejection is respectfully traversed.

Examiner Muromoto states on page 2, lines 9-12 of the April 07, 2006 Office

Action:

Claims 16 and 18 provide for the use of a vest, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Applicants disagree.

Claims 16-18 are not “use” claims or “method/process” claims, but are clearly article claims. Claim 16 is specifically directed to an ice vest comprising up to about 6 pockets. Ice vests are simply vests that are capable of housing one or more pieces of ice. See, for example, Applicants’ original specification, page 12, line 5 to page 13, line 24, which clearly describes ice vests. Claim 17 further describes the vest (i.e., article) of claim 16, wherein the vest is in combination with one or more pieces of ice or dry ice. Claim 18 is specifically directed to a dosimetry vest comprising about 5 pockets. Dosimetry vests are simply vests that are capable of housing one or more dosimetry devices (i.e., devices capable of measuring exposure to a substance such as nuclear radiation). See, for example, Applicants’ original specification, page 13, line 26 to page 14, line 12, which clearly describes dosimetry vests.

It is difficult for Applicants to understand how Examiner Muromoto and SPE Calvert can even consider claims 16-18 to be method/process claims. However, for at least

the reasons given above, Applicant respectfully submits that claims 16-18 are clearly article claims that meet the definiteness requirements of 35 U.S.C. §112, second paragraph. Accordingly, withdrawal of this rejection is respectfully requested.

Rejection Under 35 U.S.C. § 101

Previously presented claims 16-18 were also rejected as allegedly not meeting the statutory patentability requirements of 35 U.S.C. § 101. This rejection is respectfully traversed.

Examiner Muromoto states on page 2, lines 13-17 of the April 07, 2006 Office Action:

Claims 16-18 are is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 225 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Applicants disagree.

For at least the reasons given above, claims 16-18 are clearly article claims. Again, it is difficult for Applicants to understand how Examiner Muromoto and SPE Calvert can even wonder whether claims 16-18 meet the statutory patentability requirements of 35 U.S.C. § 101. However, for at least the reasons given above, Applicant respectfully submits that claims 16-18 are clearly article claims that meet the statutory patentability requirements of 35 U.S.C. § 101. Accordingly, withdrawal of this rejection is respectfully requested.

Obviousness-Type Double Patenting Rejection

Previously presented claims 1-3, 5-13, 15, 19-20, 35-36 and 40-42 were rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-12, 14-18, 22, 25-27 and 30 of U.S. Patent No. 6,854,135. This rejection is respectfully traversed.

The claims of U.S. Patent No. 6,854,135 are directed to reusable, launderable coveralls comprising water-soluble material. The claims of U.S. Patent No. 6,854,135 do not have anything to do with vests as disclosed and claimed in the present application. Further,

one skilled in the art clearly understands the differences between coveralls and vests as clearly described in U.S. Patent No. 6,854,135 and the present application.

It is respectfully submitted that one skilled in the art, given U.S. Patent No. 6,854,135, would not have been motivated to make Applicants' claimed vest as suggested by Examiner Muromoto. Further, it is respectfully submitted that U.S. Patent No. 6,854,135 does not teach, disclose or suggest vests comprising water-soluble material as recited in the present claims.

For at least the reasons given above, Applicants respectfully submit that the obviousness-type double patenting rejection in view of U.S. Patent No. 6,854,135 is improper. Accordingly, withdrawal of this rejection is respectfully requested.

Previously presented claims 14, 33-34, 37-39 and 43-45 were rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-12, 14-18, 22, 25-27 and 30 of U.S. Patent No. 6,854,135 in view of U.S. Patent No. 5,931,971 to Zucker (hereinafter, "Zucker"). This rejection is respectfully traversed.

As discussed above, the claims of U.S. Patent No. 6,854,135 do not have anything to do with vests as disclosed and claimed in the present application. The teaching of Zucker also does not have anything to do with vests as disclosed and claimed in the present application. The teaching of Zucker is directed to water-soluble rags used to absorb hydrocarbons. The water-soluble rags are subsequently dissolved in a hot water bath so that the water-soluble material and the hydrocarbons separate in the hot water bath (i.e., the hydrocarbon rise to the top surface of the hot water bath).

Even if the proposed combination of the teaching of U.S. Patent No. 6,854,135 with the teaching of Zucker is proper (and Applicants submit that it is not), the proposed combination fails to teach, disclose or suggest vests comprising water-soluble material as recited in the present claims.

For at least the reasons given above, Applicants respectfully submit that the obviousness-type double patenting rejection in view of U.S. Patent No. 6,854,135 in combination with the teaching of Zucker is improper. Accordingly, withdrawal of this rejection is respectfully requested.

II. Prior Art Rejections:

Rejection of Previously Presented Claims 1-2, 5-6, 13-16, 18-20 and 33-45 Under 35 U.S.C. §103(a) In View of Zucker

Previously presented claims 1-2, 5-6, 13-16, 18-20 and 33-45 were rejected under 35 U.S.C. §103(a) as unpatentable over Zucker. This rejection is respectfully traversed.

As discussed above, the teaching of Zucker is directed to water-soluble rags and the use of water-soluble rags to absorb hydrocarbons (oil). The teaching of Zucker fails to teach, disclose or suggest vests, and particularly vests comprising water-soluble material as recited in Applicant's claimed invention.

On page 4, lines 6-10 the April 10, 2006 Office Action, Examiner Muromoto states:

With respect to the vest limitation, a vest is simply a well-known species of the well-known genus of garments. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to construct any number of articles and garments, including vests, from the fabric material taught by Zucker for a desired particular end use or application.

Applicants disagree.

Applicants respectfully submit that one of ordinary skill in the art, given the teaching of Zucker, would not have been motivated to "construct any number of articles and garments, including vests, from the fabric material taught by Zucker for a desired particular end use or application" as suggested by Examiner Muromoto. There simply is no suggestion of vests comprising water-soluble material in the teaching of Zucker. Further, there is no suggestion of the desirability of vests comprising water-soluble material or the desirability to construct vests out of the disclosed water-soluble fabrics of Zucker. As stated by the Court in *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990), "The mere fact that references can be combined or modified does not render the resultant combination (or modification) obvious unless the prior art also suggests the desirability of the combination (or modification). (In *Mills*, claims were directed to an apparatus for producing an aerated cementitious composition by drawing air into the cementitious composition by driving the output pump at a capacity greater than the feed rate. The prior art reference taught that the feed means can be run at a variable speed, however the court found that this does not require that the output pump be run at the claimed speed so that air is drawn into the mixing chamber

and is entrained in the ingredients during operation. Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." *Id.* at 682, 16 USPQ2d at 1432.). See also *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992).

Applicants respectfully submit that the only motivation and suggestion of the desirability of a vest comprising water-soluble material has been gleaned from Applicants' own specification, not from what is disclosed, taught or suggested in the prior art. For at least this reason, Applicants respectfully submit that the proposed modification of the teaching of Zucker and the obviousness rejection based on the teaching of Zucker is improper.

It should be further noted that the teaching of Zucker fails to teach, disclose or suggest Applicants' claimed vest as embodied in numerous dependent claims. For example, the teaching of Zucker fails to teach, disclose or suggest a vest comprising pre-washed water-soluble material (claim 2); a vest comprising two or more nonwoven fabric sheets joined to one another with one or more sheet fastening devices (claim 14); and a vest comprising one or more pockets (claims 15-16 and 18).

For at least the reasons given above, the teaching of Zucker fails to make obvious Applicants' claimed invention as embodied in independent claims 1, 35 and 40. Since claims 2, 5-6, 13-16, 18-20, 33-34, 36-39 and 41-45 depend from independent claims 1, 35 and 40, and recite additional claim features, the teaching of Zucker also fails to make obvious Applicant's claimed invention as embodied in dependent claims 2, 5-6, 13-16, 18-20, 33-34, 36-39 and 41-45. Accordingly, withdrawal of this rejection is respectfully requested.

Rejection of Previously Presented Claims 7-12 Under 35 U.S.C. §103(a) as being
Unpatentable over Zucker in view of Langley

Previously presented claims 7-12 were rejected under 35 U.S.C. §103(a) as being unpatentable over Zucker in view of U.S. Patent No. 5,869,193 to Langley (hereinafter, "Langley"). This rejection is respectfully traversed.

Claims 7-12 depend from independent claim 1 and further recite that the claimed vest comprises a closure system (claims 7-9) or two or more nonwoven fabric sheets joined to one another with one or more sheet fastening devices (claims 10-12). The closure

system and/or sheet fastening devices may also comprise water-soluble material (claims 9 and 12).

As discussed above, the teaching of Zucker fails to teach, disclose or suggest vests, and in particular vests comprising water-soluble fabric material. In addition, the teaching of Zucker fails to teach, disclose or suggest such vests comprising closure systems or sheet fastening devices as recited in claims 7-12.

The teaching of Langley is directed to a polyvinyl alcohol (PVA)/polyvinylidene chloride (PVDC) laminated sheet materials suitable for use in protective wear so as to provide water splash resistance as well as resistance to organic solvents. See, for example, Langley, column 7, lines 24-38.

Like the teaching of Zucker, the teaching of Langley fails to teach, disclose or suggest vests comprising water-soluble fabric material formed from water-soluble polyvinyl alcohol fibers as recited in Applicants' independent claim 1. Further, like the teaching of Zucker, the teaching of Langley fails to teach, disclose or suggest vests comprising closure systems or sheet fastening devices.

Regarding the proposed combination of the teaching of Zucker with the teaching of Langley, Examiner Muromoto states on page 6, lines 6-14 of the April 10, 2006 Office Action:

Although Zucker teaches all of the limitations of the claimed invention, Zucker does not teach a closure system for the garment, that the garment has more than one non-woven sheet joined with fastening devices and the nature of the fastening devices.

However, Langley does teach a multi-layered material that used heat sealing and adhesives to join non-woven laminated sheets of PVA (water soluble) and PVDC (water-dispersible) to form protective articles such as suits, gloves, and other garments.

Therefore it would have been obvious to one of ordinary skill in the art to modify Zucker to use adhesives to join separate sheets of material to form protective articles such as vests.

Applicants disagree.

It should be noted that the teaching of Zucker does not teach "all of the limitations of the claimed invention" as suggested by Examiner Muromoto for at least the reasons given above. Further, it should be noted that the teaching of Langley does not teach "non-woven laminated sheets of PVA (water soluble) and PVDC (water-dispersible)" as

suggested by Examiner Muromoto. The disclosed sheets of PVA and PVDC are films, not nonwovens as suggested by Examiner Muromoto.

It should be further noted that the teaching of Zucker discloses fabrics formed from water-soluble PVA fibers and individual sheets cut from such a fabric. The teaching of Zucker does not teach, disclose or suggest any multi-fabric articles or the desire to combine individual sheets so as to form multi-fabric articles as suggested by Examiner Muromoto. Given the teaching of Zucker alone or in combination with the teaching of Langley, one of ordinary skill in the art would not have been motivated to modify the disclosed individual sheets of Zucker as proposed by Examiner Muromoto. As discussed above, the prior art must suggest the desirability of the combination (or modification) in order to make obvious Applicants' claimed invention. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

For at least the reasons given above, Applicants respectfully submit that the proposed combination of the teaching of Zucker with the teaching of Langley fails to make obvious Applicants' claimed invention as embodied in dependent claims 7-12. Accordingly, withdrawal of this rejection is respectfully requested.

III. Conclusion:

Applicants respectfully submit that claims 1-3, 5-20 and 33-45 define patentable subject matter. Accordingly, Applicants respectfully request allowance of these claims.

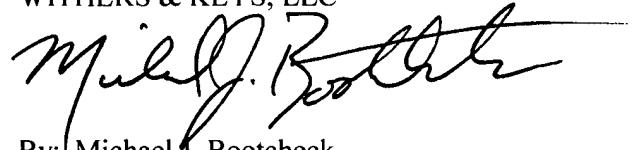
No additional fees are believed due; however, the Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, to Deposit Account No. 503025.

Should Examiner Muromoto believe that anything further is necessary to place the application in better condition for allowance, Examiner Muromoto is respectfully requested to contact Applicants' representative at the telephone number listed below.

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Respectfully submitted,

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